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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,811	01/13/2004	Michael Tjader	1523.056US1	1505
21186	7590	11/16/2005	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 1600 TCF TOWER 121 SOUTH EIGHT STREET MINNEAPOLIS, MN 55402			COY, NICOLE A	
		ART UNIT	PAPER NUMBER	
		3672		

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/756,811	TJADER, MICHAEL
	Examiner Nicole Coy	Art Unit 3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
  - 4a) Of the above claim(s) 15-18 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) 1-18 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/9/2004</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: ____.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14, drawn to a device, classified in class 405, subclass 184.3.
  - II. Claims 15-18, drawn to a method, classified in class 166, subclass 298.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus or by hand.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with David Peterson on November 8, 2005 a provisional election was made without traverse to prosecute the invention of Group 1, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4-6, 8-11, and 13 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Carter et al. (US Application 2002/0067954).

With respect to claim 1, Carter et al. discloses a pipe breaking device, comprising: a base unit (see figure 2 number 140); a retention feature located on the base unit (see figure 2, numerals 188, 196, and 160); a cable attachment portion located at a first end of the base unit (see figure 2 numeral 48); and a number of pipe engaging elements wherein the pipe engaging elements are retained on the base unit by the retention feature, and wherein the number of pipe engaging elements are removable from the base unit and interchangeable (see figure 2 numerals 56 and 52 and column 3 paragraph [0054]).

With respect to claim 4, Carter et al. discloses that the retention feature includes a threaded fastener that connects at least one of the number of pipe engaging elements to the base unit (see figure 2 numeral 160 and column 3 paragraph [0052]).

With respect to claim 5, Carter et al. discloses a pipe breaking device further including a pipe gripping device located at a second end of the base unit, opposite the cable attachment location (see figure 2 numeral 156 and column 3 paragraph [0052]).

With respect to claim 6, Carter et al. discloses that the pipe gripping device includes a wedge and at least one wedge mating portion (see figure 24 numeral 1196).

With respect to claim 8, Carter et al. discloses at least one of the number of pipe engaging elements includes a cutting blade (see figure 2 numeral 56).

With respect to claim 9, Carter et al. discloses that the cable attachment portion includes a threaded portion adapted to mate with a corresponding threaded portion on the first end of the base unit (see figure 24 numeral 1194).

With respect to claim 10, Carter et al. discloses the cable attachment portion includes multiple segments adapted for assembly around a cable (see figure 24).

With respect to claim 11, Carter et al. discloses a pipe breaking device, comprising: a base unit (see figure 2 number 140); a retention feature located on the base unit (see figure 2, numerals 188, 196, and 160); a threaded cable attachment portion located adapted to mate with a corresponding threaded portion on a first end of the base unit (see figure 24 numeral 1194); a number of pipe engaging elements wherein the pipe engaging elements are retained on the base unit by the retention feature, and wherein the number of pipe engaging elements are removable from the base unit and interchangeable (see figure 2 numerals 56 and 52 and column 3 paragraph [0054]); and a pipe gripping device located at a second end of the base unit, opposite the cable attachment location (see figure 2).

With respect to claim 13, Carter et al. discloses at least one of the number of pipe engaging elements includes a cutting blade (see figure 2 numeral 56).

4. Claims 1-3, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Lincoln (USP 6,109,832).

With respect to claim 1, Lincoln discloses a pipe breaking device, comprising: a base unit (see figure 2B); a retention feature located on the base unit (see figure 2B, numeral 24); a cable attachment portion located at a first end of the base unit (see figure 2B numeral 28); and a number of pipe engaging elements wherein the pipe engaging elements are retained on the base unit by the retention feature, and wherein the number of pipe engaging elements are removable from the base unit and interchangeable (see figures 4A and 5A).

With respect to claim 2, Lincoln discloses that the base unit includes a round shaft with a first diameter (see figure 2B numeral 26), and the retention feature includes a shoulder portion having a diameter larger than the first diameter (see figure 2B numeral 24).

With respect to claim 3, Lincoln discloses the shoulder portion is located at a second end of the base unit, opposite the cable attachment location (see figure 2B).

With respect to claim 7, Lincoln et al. discloses at least one of the number of pipe engaging elements includes an expander cone (see figure 4A).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carter et al. in view of Lincoln.

With respect to claim 12, Carter et al. is silent as to whether the expander cone is a pipe engaging element which is removable and interchangeable. Lincoln teaches a removable and interchangeable expander cone in order to allow for the removal of the bursting ram in limited space (see figure 4A and column 3 lines 8-15). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the pipe breaking device of Carter et al. by including a removable expander cone as taught by Lincoln in order to allow for the removal of the device in limited space.

With respect to claim 14, Lincoln teaches at least one of the number of pipe engaging elements includes a cutting blade (see figure 4A and column 3 lines 8-15). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the pipe breaking device of Carter et al. by including a removable expander cone and cutting blade as taught by Lincoln in order to allow for the removal of the device in limited space.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicole Coy whose telephone number is 571-272-5405. The examiner can normally be reached on M-F 8:00-5:30, 1st F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Nicole A. Coy*

nac

*William Neuder*  
William Neuder  
Primary Examiner